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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/289,346	04/09/99	HANLEY-BOWDOIN	L 5051-458

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HM22/0103

EXAMINER

DRABIK, C

ART UNIT

PAPER NUMBER

1633

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DATE MAILED:

01/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b> 09/289,346	<b>Applicant(s)</b> HANLEY-BOWDOIN ET AL.	
	<b>Examiner</b> Christopher Drabik	<b>Art Unit</b> 1633	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-59 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 20) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-41, 58 and 59 drawn to a transgenic plant comprising a mutated geminivirus AL1 gene and a method of combating geminivirus infection, classifiable in class 800, subclasses 279 and 298.
- II. Claims 42-55 drawn to nucleic acid constructs encoding mutated AL1 proteins, classifiable in class 536, subclass 23.72.
- III. Claims 56 and 57 drawn to a method of screening nucleic acid constructs for conferring to a plant increased geminivirus resistance, said nucleic acid constructs comprising mutations in the AL1 protein, classifiable in classes 435 and 536, subclasses 5 and 23.72 respectively.

Inventions I and II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). The claims of Group I are directed toward a transgenic plant which has been transformed with a nucleic acid construct encoding mutated AL1 protein. The claims of Group II are directed toward a nucleic acid construct. The invention of Group II can be used in a method of

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making the invention of Group I, however, Group II can be used to achieve ends other than the generation of a transgenic plant, therefore, Group I is distinct from Group II.


Invention I is distinct from invention III. Inventions are unrelated if it can be show that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the claims of Group I are directed toward a transgenic plant which has been transformed with a nucleic acid construct encoding mutated AL1 protein. Invention I pertains to a geminivirus resistant plant. The claims of Group III involve a method of producing and screening nucleic acid constructs for conferring increased resistance to geminiviral infection. Since the claims of group I and III are unrelated inventions, I and III are distinct.

Invention II is distinct from invention III. Inventions are unrelated if it can be show that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The invention of Group II is directed to nucleic acid constructs encoding mutated geminivirus AL1 proteins. The claims of Group III involve a method of producing and screening nucleic acid constructs for conferring increased resistance to geminiviral infection. Since the nucleic acid

constructs of Group II are unrelated to the methods of Group III, Group II is distinct from Group III.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Drabik whose telephone number is 703-605-1156. The examiner can normally be reached on Monday-Friday from 9am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark, can be reached on (703) 703-305-4051. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234. Questions regarding review of formality issues may be directed to Kim Davis, the patent analyst assisting in this application. She may be reached at 703-308-4242.

  
**DEBORAH J. R. CLARK**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**